

REMARKS/ARGUMENTS

This is a Response to Office Action to Office Action dated August 13, 2003. Claims 1-34 and 44-50 are canceled. Claim 41 is amended. Claims 35-43 are pending.

Objections

Claims 31-34 are objected to. Claims 31-34 are canceled, rendering the claim objections moot.

Rejection Under 35 U.S.C. 251

Claims 35-50 are rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration.

35 U.S.C. 251 provides in relevant part: “Whenever any patent is ... deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent”

Applicants have complied with 35 U.S.C. 251, because applicants now seek to claim less than the originally issued claims. The pending claims use the language “only one single mode core” as compared to the originally issued claims “a single-mode core”. The United States Court of Appeals for the Federal Circuit stated in KCJ Corporation v. Kinetic Concepts, Inc., 222 F.3d 1351, 1356 (Fed Cir. 2000): “This court has repeatedly emphasized that an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” Whereas the claim language “a single-mode core” in the originally issued claims carries the meaning of one or more single-mode cores, the pending claims carry the meaning of only one single mode core. Thus, the reissue declaration properly cited the basis that the issued claims were too broad, and complies with 35 U.S.C. 251.

For at least the above reasons, applicants respectfully request withdrawal of the rejection under 35 U.S.C. 251 against claims 35-50.

Rejection Under 35 U.S.C. 251

Claims 44-50 are rejected under 35 U.S.C. 251 as being broadened in a reissue outside the two year statutory period. Claims 44-50 are canceled.

Estoppel

Claims 37-50 are rejected based on estoppel.

1. Applicants are Not Estopped From Prosecuting the Pending Claims, Because Prosecuting the Pending Claims is Consistent with Applicants Actions in the Interferences

The only actions in *ex parte* prosecution that Rule 658(c) proscribes are those that are *inconsistent* with a party's failure to file a motion in an interference under Rules 633 or 634:

A losing party who could have properly moved, but failed to move, under §§ 1.633 or 1.634, shall be estopped to take *ex parte* or *inter parte* action in the Patent and Trademark Office after the interference *which is inconsistent with that party's failure to properly move* (37 CFR § 1.658(c), emphasis added).

Applicants' present pursuit of claims 37-50 is entirely *consistent* with not seeking to have these claims added to Interferences 104,069 and 104,075 or made the subject of another interference against Grasso, et al. Applicants were adopting precisely the same position that applicants are adopting here. The claims could not be added in the interference because of lack of support, and the currently claimed subject matter is patentably distinct from the subject matter of the lost count of Interferences 104,069 and 104,075 and from the Grasso, et al., patent.

A losing party to an interference is entitled to claim subject matter other than that of the interference count, provided the requirements of patentability are met, and subject to those constraints that flow from the adverse decision in the interference. *In re Zletz*, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989).

2. Prosecuting the Pending Claims is Consistent with Applicants Actions in the Interferences, Because the Pending Claims Did Not Have Support in Grasso, et al., and Thereby Could Not Be Added to the Interferences

The pending claims could not be added to the interference because Grasso et al. did not have support for claims reciting “only a single core.” The Grasso, et al. patent states that an amplifier having a single core gain fiber which they produced for comparison with their example fiber introduced such noise that signal reception was difficult so that the amplifier was “practically useless”. (Col. 10, lines 56-61.) Thus, the pending claims did not have support in Grasso, et al., and could not be added to the interferences. Presenting the pending claims in the instant application is entirely consistent with applicants’ position in the prior interferences.

3. Prosecuting the Pending Claims is Consistent with Applicants Actions in the Interferences, Because Applicants Have Retained the Function Of Selected Attenuation While Eliminating a Core, Making The Interference Counts Patentably Distinct From the Pending Claims

The amplifier claimed herein has “only one single-mode core” but still performs the function of selected attenuation.

The MPEP states at § 2144.04:

II. ELIMINATION OF A STEP OR AN ELEMENT AND ITS FUNCTIONS

B. Omission of an Element with Retention of the Element’s Function Is an Indicia of Unobviousness

Note the omission of an element and retention of its function is an indicia of unobviousness. In re Edge, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (emphasis is in the original).

In Edge the claims were directed to a printed sheet having a thin layer of erasable material bonded directly to the sheet whereas the prior art disclosed a similar printed sheet with an intermediate transparent layer between the sheet and the layer of erasable material. Edge eliminated the transparent layer but maintained the function of erasing the middle layer without erasing the printed indicia. Similarly, in the present case, applicants have eliminated a core in the gain fiber, but have retained the function of selectively attenuating certain wavelengths of light. This is an indicia of unobviousness.

4. Prosecuting the Pending Claims is Consistent with Applicants Actions in the Interferences, Because the Grasso et al. Patent Teaches Away From Making an Amplifier With a Single Core Gain Fiber, Making the Interference Counts Patentably Distinct From the Pending Claims

The prior art in this matter is the Grasso et al. patent, which states that an amplifier having a single core gain fiber which they produced for comparison with their example fiber introduced such noise that signal reception was difficult so that the amplifier was “practically useless”. (Col. 10, lines 56-61.) This is a textbook case of teaching away from the invention, which Hall et al. had made. See MPEP § 2145 X. D. References teach away from the invention or render prior art unsatisfactory for intended purpose, and In re Hedges 783 F 2d 1038 1041 (Fed. Cir. 1986).

In Hedges, the claim at issue related to a process for preparing sulfonic acids. The prior art references taught that lower temperatures of reaction are preferable. Hedges claimed a reaction in the molten state. The prior art taught away from the claimed invention of carrying out the reaction in the molten state. This was strong evidence of unobviousness citing W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1552, 200 USPQ 303 312 (Fed. Cir. 1983), cert. denied, 105 S. Ct. 172 (1984), citing United States v. Adams, 383 U.S. 39, 148 USPQ 479 (1996). In re Hedges 783 F 2d 1041 (Fed. Cir. 1986).

In the present case Grasso et al. states that only a double core fiber will provide the desired attenuation characteristics. Hall et al. claims using a fiber with a single-core. The claimed invention is unobvious.

Thus, for at least the above reasons, prosecuting the pending claims is entirely consistent with applicants' actions in the interferences, and the estoppel provision of Rule 658(c) is plainly inapplicable. Applicants therefore respectfully request that the estoppel rejection of claims 37-50 be withdrawn.

Upon an indication of allowability, the original patent will be surrendered.

Appl. No. 09/105,572
Amdt. Dated December 11, 2003
Reply to Office Action of Aug. 13, 2003

CONCLUSION

It is submitted that the present application is in form for allowance, and such action is respectfully requested.

The Commissioner is authorized to charge any additional fees, which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 20397.845.201).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

Date: 12/11/03


Kenta Suzuki, Reg. No. 45,145

650 Page Mill Road
Palo Alto, CA 94304
(650) 565-3995
Customer No. 021971